

REMARKS

The preceding amendments and following remarks form a complete response to the Office Action of November 12, 2008. Applicants have amended claim 5 and the title of the invention without adding any new matter. Support for the amendment to claim 5 can be found, *inter alia*, in paragraph 19 of the Specification. Claim 11 was withdrawn from consideration. Accordingly, claims 1-12 are pending in the present application.

The Office objected to the Title of the Invention for allegedly lacking descriptiveness. Although Applicants disagree, the Applicants have amended the Title to include more detail. Applicants, therefore, respectfully request withdrawal of the objection.

Claim 5 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly failing to particularly point out and claim the subject matter of the invention. Applicants submit that the amendment to claim 5 obviates the Office's rejection and, therefore, respectfully request the withdrawal of the rejection to claim 5 under § 112.

The Office rejected claims 1-7, 9-10, and 12 under 35 U.S.C. § 102 as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,471,248 to Hardwick et al. ("Hardwick"). Applicants traverse the rejection on the basis that Hardwick fails to disclose or suggest each and every element of claims 1-7, 9-10 and 12, and the subject matter of claims 1-7, 9-10 and 12 would not have been obvious in view of the teachings of Hardwick.

Independent claim 1 recites a data carrier having a first side and a second side. The data carrier comprises at least one printed area produced by intaglio printing on the first side. The printed area has a tactile perceptibility. The data carrier also includes a

film applied on the first side and partly covering the printed area. The film is applied such that the tactile perceptibility of the intaglio printing is maintained.

Hardwick discloses a security document comprising a sheet-like substrate of clear plastic material having a lower surface 11 and a second upper surface 12. See Hardwick at col. 3, lines 55-64; FIG 1 (reproduced below). Layers 13 and 14 of opacifying ink are applied to the first surface 11 and layers of 15 and 16 of opacifying ink are applied to the upper surface 12. The security document also includes a security device 20 on the lower surface 11 of the clear plastic substrate 10. That is, the security device 20 is embedded in the security document between the substrate 10 and layers of opacifying ink 13 and 14 which completely cover both sides of the device 20. The opacifying layers of ink 15 and 16 are not applied over the entire surface 12 of the substrate 10 and thus leave an area of the second surface 12 that is not covered by the ink, which forms a "half-window" 18 on one side of the substrate. *Id.* Hardwick discloses that a variety of security devices 20 may be applied to the substrate including fine line or filigree patterns, micro-text, security stripes or threads, front and rear registration device, Moire patterns, embossing, etc.

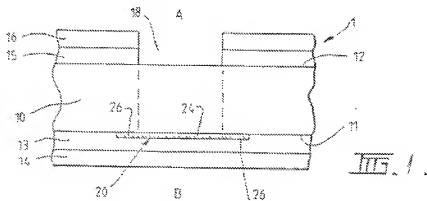
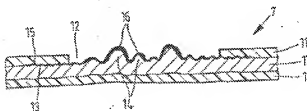


FIG. 1 of Hardwick

The Office Action asserts that the claimed invention is the same as the product disclosed by Hardwick. See Office Action at 4. It is not; the claimed invention is quite different from Hardwick on a very basic level. For instance, Hardwick fails to disclose or suggest a data carrier having a printed area having tactile perceptibility, as defined by claim 1. The Office alleges that because the security device of Hardwick can be, amongst other things, embossed, that the security device would be tactically perceptible. See Office Action at 3. However, security device 20 is embedded in the data carrier under plastic layer 10 and, therefore, the data carrier of Hardwick does not have a printed area having tactile perceptibility, let alone one that has a film applied on the first side and partly covering the printed area such that the tactile perceptibility of the intaglio printing is maintained. Instead, Hardwick is more concerned with the optical appearance of the security device. See *e.g.*, Hardwick at Abstract; col. 4, lines 46-56.

In stark contrast to Hardwick, in the present invention, the embossing 14 and thicker inking 16 are tactilely perceptible through the gap 12. See, *e.g.* Present Application at ¶¶ 41-44; FIG 3 (reproduced below).



Applicant's FIG. 3

Thus, Hardwick fails to disclose a data carrier having tactile perceptibility as required by claim 1. For this independent reason, the rejection of claim 1 and its dependent claims 2-7, 9-10, and 12 is improper and should be withdrawn.

Claim 1 is patentable over Hardwick for the separate, independent reason that Hardwick fails to disclose or suggest a film applied to the first side of the data carrier covering the printed area wherein the film is applied such that tactile perceptibility of the printing is maintained. The Office erroneously alleges that Hardwick's opacifying ink 15 and 16 constitute such a film. See Office Action at 3. At best, however, inks merely block the visibility of the security device. They do not protect against forgery and mechanical wear like the film of the present invention. See generally, Present Application at ¶¶ 13-17. Furthermore, the security device 20 is covered with a plastic film 10 that destroys any possible tactile perceptibility in the security device 20 of the data carrier of Hardwick. Thus, for this additional reason, the rejection of claim 1 and its dependent claims 2-7, 9-10, and 12 is improper and should be withdrawn.

As Hardwick fails to disclose or suggest each and every element of the claimed invention, Applicants respectfully request the withdrawal of the rejection of claim 1 and its dependent claims 2-7, 9-10, and 12.

The Office rejected claims 1-10 and 12 under 35 U.S.C. § 103(a) as allegedly unpatentable over the combination of Hardwick and U.S. Patent No. 6,505,779 to Power et al. ("Power"). Applicants traverse the rejection on the basis that claims 1-10 and 12 recite subject matter neither disclosed nor suggested by the combination of Hardwick and Power.

For instance, for at least the reasons stated above, claim 1 is patentable over Hardwick. Power, which the Office cites for its disclosure of the advantages of intaglio printing fails to remedy the deficiencies of Hardwick with respect to claim 1.

Power fails to disclose a data carrier having at least one printed area produced by intaglio printing on the first side and having a tactile perceptibility and a film applied on the first side and partly covering said printed area, wherein the film is applied such that the tactile perceptibility of the intaglio printing is maintained, as claim 1 requires. Instead, Power merely describes a security document with security indicia being detectable in transmitted light. *See* Power at col. 1, line 55 – col. 2, line 11. In order to conceal the security indicia in reflected light, the security document further comprises a complex security pattern, for example formed of a print in the area of the security indicia, which is described as being formed of at least partly transparent windows. *Id.* According to Power, the security pattern can be produced by different printing techniques. According to Power, a more complex security pattern (for example by providing several elements, irregularity and respective dimensions) conceals the window areas better. One embodiment discloses that the security pattern is produced by intaglio printing. The produced three-dimensional structures are to help concealing the window areas (security feature) upon oblique viewing angles of the security document (column 2, lines 39 to 35).

The Office alleges that while Hardwick fails to explicitly disclose printing the layers of opacifying ink using intaglio printing, Power does. *See* Office Action at 4. Regardless of whether this assertion is correct, it is completely irrelevant to the present invention. Since the Office is taking the view that the opacifying ink layers correspond

to the film of the present invention, it does not matter whether the film was produced through intaglio printing. Indeed, modifying Hardwick as the Office suggests would produce a "film" created through intaglio printing and not at least one printed area produced by intaglio printing on the first side and having a tactile perceptibility and a film applied on the first side and partly covering said printed area, wherein the film is applied such that the tactile perceptibility of the intaglio printing is maintained, as claim 1 requires. As Power fails to remedy the deficiencies of Hardwick with respect to claim 1, Applicants respectfully request withdrawal of the rejection of claim 1 and its dependent claims 2-10 and 12.

The Office rejected claims 5 and 7 under 35 U.S.C. § 103(a) as unpatentable over the combination of Hardwick, Power, and U.S. Patent No. 6,474,695 to Schneider et al. ("Schneider"). Applicants traverse the rejection on the basis that claims 5 and 7 recite subject matter neither disclosed nor suggested by the combination of Hardwick, Power, and Schneider. For instance, claims 5 and 7 are patentable over Hardwick and Power for the same reasons stated above. Schneider, which the Office views as teaching security bank notes and ID cards having optically effective structures such as embossed holograms or diffraction or relief structures to affect the different viewing angles and coloring (*see* Office Action at 6), fails to remedy the deficiencies of Hardwick and Power with respect to claim 1. Applicants, therefore, respectfully request the withdrawal of the rejection of claims 5 and 7.

In view of the above, all rejections have been sufficiently addressed. Applicants submits that the application is now in condition for allowance and requests that the Office allow claims 1-10 and 12 and pass this application to issue.

In the event that this paper is not timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account No. 02-2135.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

Respectfully submitted,

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